

BEST AVAILABLE COPYApplication No.: 10/517,021Case No.: 57911US004**REMARKS**

Favorable reconsideration is respectfully requested in light of the amendments made above and the following comments. Claim 3 has been amended herein, and claims 9-19 have been added herein. No new matter has been added as a result of this amendment.

Support for the amendment to claim 3 can be found at least at page 2, paragraph [0020], lines 11-14. The claims added herein are also fully supported by the specification. Support can be found at least at page 2, paragraph [0026], lines 7-8 (claims 9, 10, 15, and 16); page 4, paragraph [0051], lines 1-2 (claims 11, 12, 13, and 14); page 4, paragraph [0045], lines 3-12 (claims 17, 18, and 19).

Rejection of Claims Under 35 USC § 103

The Office Action rejected claims 3 and 5-8 under 35 USC § 103(a) as being obvious over Umeya, U.S. Pat. No. 5,859,122 ("Umeya") in view of Ho et al, U.S. Pat. No. 6,607,831 ("Ho") and Anderson et al, U.S. Publ. No. 2003/0232222 ("Anderson"). The Advisory Action has maintained that rejection and asserts that the request for reconsideration filed on July 31, 2006 does not place the application in condition for allowance. Applicant respectfully traverses this rejection.

Although Applicant maintains that claims 3 and 5-8 are not obvious over Umeya in view of Ho, and Anderson, claim 3 has been amended herein to specify that "the primer layer effectively prevents the plasticizer from migrating from the base material to the adhesive sheet".

Applicant respectfully asserts that amended claim 3 is neither obvious in light of Umeya, nor any combination of the cited references. Specifically, Applicant asserts that neither Umeya, nor any combination of the cited references even provides a suggestion or motivation to utilize Umeya's composition as a primer layer on a base material containing plasticizers, where the migration of the plasticizers is a concern. The references certainly do not suggest using a primer layer to effectively prevent the plasticizer from migrating from the base material to the adhesive sheet, as claim 3 recites.

Umeya offers no disclosure, and no suggestion regarding anything related to plasticizers. The Office Action and the Advisory Action also does not provide any teaching or suggestion that the compositions of Umeya, or even similar compositions have any effect on plasticizers. Therefore, one of ordinary skill in the art would not have been motivated to utilize Umeya's compositions in a situation where plasticizer migration was an issue, and certainly not where is

BEST AVAILABLE COPYApplication No.: 10/517,021Case No.: 57911US004

was desired to effectively prevent plasticizer migration from a base material to an adhesive sheet. Indeed, Umeya does not even offer any disclosure or suggestion about interactions between the material to be treated (i.e. fiber in Umeya) and any other overlying layer, it is entirely concerned with the properties of the treated fiber itself. Furthermore, neither Ho nor Anderson discloses or suggests that a polycarbonate polyurethane composition has any advantage, or even any use as a primer layer in multi-layer structures, and certainly do not provide any teaching of the very specific situation where plasticizer migration is a concern in a multi-layer structure.

Contrary to that, Applicant's specification (US 2005/0245674, paragraph [0005]) specifically discusses plasticizer resistance, and states that it means that a plasticizer contained in a base material is prevented from moving to the adhesive layer of an adhesive sheet. The importance of such a property is also discussed: if the plasticizer moves to the adhesive layer, the cohesive force of the adhesive layer is impaired. Such a decrease in the cohesive force induces a decrease in the adhesive force of the adhesive sheet with the base material and may cause the adhesive sheet to release from the bonded structure during use. Using Applicant's motivation as a motivation to combine Umeya with Ho and/or Anderson would constitute impermissible hindsight reconstruction.

With respect to newly presented claims 17, 18, and 19, Applicant asserts that neither Umeya, nor any combination of the references offers any disclosure or suggestion regarding a support member, or the use thereof. With respect to Umeya, one of skill in the art would not have been motivated to utilize a support member on an adhesive layer, because that would attach it to the fiber structure. Because Umeya was concerned about the softness and pliability of the fiber, the addition of a support member would contradict the stated purpose of the structure of Umeya by making the fiber less pliable.

With respect to newly presented claims 9-16, Umeya does not disclose the particular elements cited therein, namely the thickness of the primer layer and the adhesive layer respectively. Furthermore, the disclosure of Umeya would not suggest any of those particular elements to one of skill in the art.

Contrary to that, Applicant's specification states that

"it is believed that such plasticizer resistance is based on the polycarbonate skeleton and polyurethane bond possessed by the polycarbonate polyol polyurethane, which results in high cohesion force. Such a cohesion force increases the intermolecular attractive force among polyurethane molecules,

BEST AVAILABLE COPYApplication No.: 10/517,021Case No.: 57911US004

effectively preventing the plasticizer from immersing into the primer layer. Therefore, the bonded structure having such a primer layer effectively prevents the plasticizer from migrating from the base material to the adhesive sheet, whereby a decrease in the cohesive force of the adhesive layer is effectively prevented." (page 2, paragraph [0020], lines 5-15)

Umeya was mostly concerned with fabric (Umeya, column 1, lines 59-67; and column 5, lines 4-10), and therefore would not have been concerned with the migration of plasticizers into an adhesive layer. Furthermore, neither Ho, nor Anderson included any discussion or mention of plasticizers.

The elements recited in claims 9-16, the thickness of both the primer layer and the adhesive layer would certainly play a role, either alone or in combination, in effectively preventing the migration of plasticizers from the base material to the adhesive layer. For at least this reason, Applicant respectfully asserts that without this particular motivation, one of skill in the art would not have been motivated to utilize these particular thicknesses of primer layer and adhesive layer respectively. Therefore, claims 9-16 are not obvious over Umeya in light of Ho and Anderson.

Based on the amendments made above, the new claims added above, and the comments offered, Applicant respectfully asserts that claims 3, 5-8, and 9-19 are not obvious over Umeya in view of Ho and Anderson. Applicant therefore respectfully requests that this rejection be withdrawn relative to claims 3 and 5-8 and not raised with respect to claims 9-19.

BEST AVAILABLE COPYApplication No.: 10/517,021Case No.: 57911US004**CONCLUSION**

In view of the above, Applicant respectfully requests withdrawal of the rejection and allowance of the claims. Prompt passage to issue is earnestly solicited. Should the Examiner feel a telephone interview would be helpful in advancing this case to allowance, Applicant invites the Examiner to contact their representative at the number listed below.

Please continue to send all future correspondence for this matter to:

Colene H. Blank, Esq.
Office of Intellectual Property Counsel
3M Innovative Properties Company
3M Center, P.O. Box 33427
St. Paul, Minnesota 55133-3427

Respectfully submitted,

September 6, 2006

Date

By: Colene H. Blank

Colene H. Blank, Reg. No.: 41,056
Telephone No.: (651) 737-2356

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833